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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/057,603

01/24/2002

Hideki Ito

9333/284

2928

7590

04/30/2004

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EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
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2653

6

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,603

Applicant(s)

ITO, HIDEKI

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1) Applicant's election with traverse of invention I (claims 1-14) in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the search could be perform for both groups. This is not found persuasive because:

as indicated in previously office action, the instant application includes two distinct inventions, one is directed to an audio device capable of reading out track files from a recordable medium, and the other is directed to method for managing track files by examining the number, names and timestamp of each track files. Therefore, the search for each invention must be done separately, further, the prior art which could apply for the invention of group I may not be applicable for group II.

The requirement is still deemed proper and is therefore made FINAL.

2) The I.D.S filed 1/24/2002 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

4) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested.

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AUDIO DEVICE CAPABLE OF PLAYING BACK AUDIO FILES FROM A
PLURALITY OF SESSIONS.

5) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

6) (e) the invention was described in:

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7) Claims *1-4,9, 11 and 13* are rejected under 35 U.S.C. 102(e) as being anticipated by KELLER et al (6,587,404).

KELLER et al discloses a an audio device and method for managing track files as claimed in claims 1 and 13, comprising:

A display (Fig.4, display 46; Fig.7, display device 46 on front bezel 44);

A read out unit for reading out track files recorded on a recordable medium (Fig.4, audio track files are read out from data storage structure 106);

A controller which manages the track files recorded on the recordable medium in each session and which displays the session

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containing the file of an arbitrary track on the display (Fig.4, CPU 94; Fig.7, display 46 displays session 200 containing the file of an arbitrary track. See also column 15, line 1 to column 16, line 59).

As to claims 2 and 11, KELLER et al shows the name of virtual disk corresponding to the session containing the file of the arbitrary track on the display (Fig.7, name of virtual disk is ``METALLICA``).

As to claims 3 and 4, KELLER et al shows the track files is compressed by MP-3 format (column 21, line 50 to column 22, line 7).

As to claim 9, KELLER et al shows the recordable medium is CD-R in column 12, lines 37-55.

8) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9) Claims 5-8,10,12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over KELLER et al (6,587,404).

KELLER et al discloses all the subject matter claimed as in claims 5,10,12 and 14, *except* to specifically show that the track files recorded in the latest session is play back first. However,

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it has been well known and generally recognized in the art that the tracks recorded on CD or any recordable medium are capable of playing back at any directions, any sequences, randomly or selected as play list. Therefore, to play back the track files recorded on latest session in KELLER et al's audio player as claimed is deem obvious to someone within the level of skill in the art.

As to claim 6, KELLER et al shows how to change the session and the tracks in the session in figures 10-12.

As to claim 7, since the audio player of KELLER et al capable of playing back track files recorded in MP-3 format, the decoder is inherent in KELLER et al's audio player.

As to claim 8, KELLER et al shows a D/A converter in figure 4, 92.

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See form PTO-892 attached herein).

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH

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whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

April 28, 2004